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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/588,085 | 07/31/2006 | Nobuyuki Kibino | Q79795 | 4026 |
| 23373 7590 12/11/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037 | | | | |
| EXAMINER | | | | |
| DAVIS, BRIAN J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1621 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 12/11/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/588,085

Applicant(s)

KIBINO ET AL.

Examiner

Brian J. Davis

Art Unit

1621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 11-14 is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 7/31/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Clarification

Due to reasons internal to the USPTO, this application has been reassigned.

Oath/Declaration

The objection to the oath/declaration, outlined in the previous Office Action, is withdrawn. The objection is improper.

Specification

The objections to the specification, outlined in the previous Office Action, have been overcome by applicant's amendment. The amendment clarifies the specification as suggested by the examiner.

Claim Objections Withdrawn

The objection to claim 11, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment deletes reference to phenol and benzyl alcohol.

112 Rejections Withdrawn, FIRST PARAGRAPH

The rejection of claim 10 under 35 USC 112, first paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment cancels the claim.

Claim Rejections - 35 USC § 112, FIRST PARAGRAPH, MAINTAINED

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 7-9 under 35 U.S.C. 112, first paragraph, is maintained for reasons of record as failing to comply with the written description requirement. Applicant states in the remarks accompanying the amendment that claim 7 has been amended to remove reference to actinoid species. However, the claim has not, if fact, been amended in such a manner. (Compare the amendments to claims 1-6 and 13.)

112 Rejections Withdrawn, SECOND PARAGRAPH

The rejection of claims 1-7, 13 and 14 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment clarifies the claim set as appropriate.

102 Rejections Withdrawn

The rejection of claim 15 under 35 USC 102(b), outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment cancels the claim.

103 Rejections Withdrawn

The rejection of claims 1-14 under 35 USC 103(a), outlined in the previous Office Action, is withdrawn. As applicant correctly points out, the rejection is predicated upon improper hindsight reasoning as well as factual misinterpretation of the prior art. (The amendment cancels claim 10.)

Allowable Subject Matter

Claims 1-6 and 11-14 are allowed. Claims 7-9 would be allowable once the 112, first paragraph, rejection maintained above has been overcome. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art remains the prior art of record. Applicant, correctly, in the latest Response has clearly outlined - and in some detail - how the instant invention patentably distinguishes over the cited art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel M. Sullivan can be reached at 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian J. Davis/
Primary Examiner, Art Unit 1621
12/5/09